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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,876	05/23/2001	Takaaki Amano	100809-16250 (SCET 18.70	9474
26304	7590	09/09/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/863,876

**Applicant(s)**

AMANO ET AL.

**Examiner**

Jean Janvier

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **Response To Applicant's Amendments**

The Examiner does not approve the new title of the invention for the same reasons cited in the last Office Action. The Examiner approves the changes made to the specification.

### **DETAILED ACTION**

#### ***Specification***

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed (See 37 CFR 1.72).

#### **Status of the claims**

Claims 7-10 were elected for prosecution on the merits and claims 1-6 were canceled, without traverse, following a restriction requirement. Thus, claims 7-10 are currently pending in the Office Action.

#### ***Claim Objections***

Claim 9 is objected to because of the following informalities:

Concerning claim 9, line 4, "applying to the customer..." should apparently be - -  
applying to the customer's order...--.

Further, it appears that the terms user and customer are used interchangeably in the claimed invention.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ikeda et al. (hereinafter Ikeda), US Patent 5,937,391A.

As per claims 7-10, Ikeda discloses a point-service system (incentive reward program) for issuing points to a customer for purchases made at various stores or shops within an online shopping mall comprising a points issuing unit 1 of fig. 1 for issuing points based on purchase amounts of the customer's or participant's transaction (col. 3: 52-53), a points management unit 2 of fig. 2 for storing the points (total points or base points) accumulated by the customer and a points redeeming unit 3 of fig. 1 for reducing a purchase amount of the customer upon

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redeeming points at any participating store or shop within the mall during a transaction (accepting and redeeming a portion of the customer's accumulated points during a transaction or when an order is submitted by the customer).

In one embodiment, Ikeda discloses a service system wherein a specific customer makes a request to buy goods (participant's action or order) from a home page of an online shopping mall and in response to this request, the service system causes the number of effective points accumulated by the customer and issued by a plurality of shops, for each purchase made at each respective shop, to be displayed on the customer's terminal or participant's unit, subsequent to identifying the customer or participant using the customer's or participant's ID, by referring to the data of each shop forming part of the online shopping mall. If the customer still decides to order a product (participant's action), then he may click on a shopping button associated with one of the displayed shops to subsequently access an order button and hence, the point-service system or service system linked to a web server of the online shopping mall is activated to issue points or redeem points at the customer's request or instructions when he inputs an order (see abstract; col. 2: 10-67; figs. 1-19).

The processes in steps S3 through S7, as shown in fig. 7, are repeated for each shop forming part of the online shopping mall. First, in step S3, **the shop information about the goods, prices, advertisement of the shop, etc. is set up.** In step S4, it is judged whether or not the shop provides a point-service. If not, it is informed in step S5 that no point-services are provided by the shop, and the process terminates for that shop. Then, the processes in and after step S3 are repeated for other shops (col. 4: 19-26; col. 7: 3-11).

In general, when a user visits the online shopping mall and decides to place an order, as shown in fig. 6, a display screen or home page of the online shopping mall is transmitted from the mall server to the customer or user, as depicted in step 2 in fig. 5. **Data related to the goods for sale, associated prices, advertisement of each shop forming part of the online shopping mall, the number of points issued to and currently accumulated by the customer at each shop, the nearest expiring term of the points held by the customer (the oldest effective term of the points among all the points accumulated by the customer) and the points issue ratio and the points redeeming ratio for each shop are displayed on the home page or screen display (before the user selects a shop or the customer's order is accepted, processed or settled-figs 5-6 and 11; col. 6: 29-38).** When the user selects a shop (sponsor) at which he wants to place an order, the user can redeem points at the shop according to the points redemption ratio available at the shop (1 Yen for each 100 points or converting points to money amount) to thereby reduce the transaction value or balance due.

Col. 5: 54 to col. 7: 28; col. 9: 3-9.

### **Response To Applicant's Arguments**

Contrary to the applicant's arguments, Ikeda teaches a system, as shown in fig. 7, where processes in steps S3 through S7 are repeated for each shop forming part of the online shopping mall. First, in step S3, **the shop information about the goods, prices, advertisement of the shop, etc. is set up.** In step S4, it is judged whether or not the shop provides a point-service. If not, it is informed in step S5 that no point-services are provided by the shop, and the process

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terminates for that shop. Then, the processes in and after step S3 are repeated for other shops (col. 4: 19-26; col. 7: 3-11).

Further, when a user visits the online shopping mall and decides to place an order, as shown in fig. 6, a display screen or home page of the online shopping mall is transmitted from the mall server to the customer or user, as depicted in step 2 in fig. 5. **Data related to the goods for sale, associated prices, advertisement of each shop forming part of the online shopping mall, the number of points issued to and currently accumulated by the customer at each shop, the nearest expiring term of the points held by the customer (the oldest effective term of the points among all the points accumulated by the customer) and the points issue ratio and the points redeeming ratio for each shop are displayed on the home page or screen display (before the user selects a shop or the customer's order is accepted, processed or settled-figs 5-6 and 11; col. 6: 29-38). In other words, data or information, including advertising, related to shops or sponsors or advertisers, providing points to the user (sharing discount), are displayed on the user's terminal or computer before the user's or customer's order is accepted, processed or settled.** When the user selects a shop (sponsor) at which he wants to place an order, the user can redeem points at the shop according to the points redemption ratio available at the shop (1 Yen for each 100 points or converting points to money amount) to thereby reduce the transaction value or balance due.

Col. 5: 54 to col. 7: 28; col. 9: 3-9.

Finally, it appears that the Applicant is inappropriately reading limitations from the specification into the claimed invention. Although the Examiner reads the claims in view of the

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specification, however, the Examiner does not read limitations from the specification into the claims. (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the current **Office Action has been made Final.**

### **Conclusion**

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 5,806,045A to Biorge et al. discloses a method and system for allocating and redeeming incentive credits between a portable device and a base device.

US Patent 6, 142, 371A to Omeda discloses a customer service system having a point value and discount rate.

US Patent 5, 537, 314 to Kanter discloses referral recognition system having a point and discount conversion tables.



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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

08/30/05

**JDJ**

**Jean D. Janvier**

**Patent Examiner**

**JEAN D. JANVIER**  
**PRIMARY EXAMINER**  
*Jean D. Janvier*